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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/709,143	11/10/2000	William C. Tate	81803F-P	3253

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EXAMINER

THEIN, MARIA TERESA T

ART UNIT PAPER NUMBER

3627

DATE MAILED: 08/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/709,143

Applicant(s)

TATE, WILLIAM C.

Examiner

Marissa Thein

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13,15,16,27 and 28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13,15,16,27 and 28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Applicant's "Amendment" filed on June 6, 2005 has been considered.

Claims 1-13, 15-16, and 27-28 have been canceled. Claims 14 and 18 are amended. Claims 14 and 18-26, and 29-36 are pending.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, claim 14 does not distinctly define the metes and bounds of the subject matter. The preamble of claim 14 does not commensurate with the body of the claim. There is no method step of "ordering goods and/or services" in the body of the claim. The body of the claim recites "providing a server", which has nothing to do with "ordering goods and/or services". Furthermore, the claim is incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. Therefore, the claim is not "useful, concrete and tangible" because it does not satisfy the intent of the preamble. Examiner recommends the Applicant to amend the claims to clearly point out step-by-step, the process of ordering goods and/or services.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14, 18-22, and 25-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,549,612 to Gifford in view of U.S. Patent No. 6,807,532 to Kolls and in further view of U.S. Patent No. 6,321,231 to Jebens et al.

Regarding claims 14 and 18-22, Gifford discloses a method for ordering goods and/or services (e-mail notification includes not only information on what triggered the email, it also includes the online interface that links to a web brokerage application. That application then allows the client (customer) to buy or sell stocks/option (goods and/or services), col. 4, lines 50-54) over a communication network (digital communication network, col. 3, lines 14-15; local or wide-area network, col. 1, lines 18-19); providing a server (Unified communications server (UC server), col. 4, lines 31-33) of a first party for sending e-mail to a receiving site of a customer (UC server sends an e-mail to a subscriber, col. 6., lines 25-26) over said communication network, the e-mail having a static section for containing static text (subscriber's message, col. 7, lines 11-13; Figure 2) and/or graphics and a dynamic area/section for containing dynamic data (Enriched E-mail has sections which contain dynamic information which are always current even if the actual e-mail message is old, col. 7, lines 46-48; Ref. no. 203, Figure 2), the dynamic data is automatically forwarded by said server to said receiving site only upon opening the e-mail at the receiving site (since the dynamic information is kept on

Art Unit: 3627

the UC server until the e-mail HTML interface requests it in response to a subscriber opening the e-mail, col. 7, lines 51-54; After opening the mail,.....the interaction controls also can load information dynamically and automatically into the document once the e-mail is opened, e.g. without requiring explicit user action after opening the e-mail, col. 7, lines 11-19).

However, Gifford does not explicitly disclose the order form for ordering goods and/or services; digital data files containing digital images and low-resolution digital image file; URL address of a second party which upon placement of an ordering using the order section will be used to send the order automatically to the second party; the URL address of said second party is different from the URL address of said first party (**claim 18**); the second party will fulfill the order placed the customer (**claim 19**); the portion of the money paid (**claims 20 and 22**); and a notice (**claim 21**). Gifford disclose the notification email includes not only information on what triggered the email, it also includes the online interface that links to a web brokerage application (order). That application then allows the client (customer) to buy or sell the stock/option (goods and/or services). By using the interface, the client can also request other information, which can be displayed in a Java applet or as a dynamically generated HTML page. (Col. 4, lines 50-59) Furthermore, Gifford discloses a messaging system which receives messages and provides access to those message in digital form across the digital communication network (col. 3, lines 16-19). Moreover, Gifford discloses non-liter message means a message that is not text-only or a message that needs to be rendered such as an image (col. 6, lines 16-19).

Kolls, on the other hand, teaches the order form for ordering goods and/or services; URL address of a second party which upon placement of an ordering using the order section will be used to send the order automatically to the second party; and the URL address of said second party is different from the URL address of said first party (**claim 18**); and the second party will fulfill the order placed the customer (**claim 19**) (col. 44, lines 14-29).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Gifford, to include the order form; URL address of a second party; the URL of the second party is different from the first party, fulfillment of the order, as taught by Kolls, in order to process the order and fulfill the order (Kolls, col. 44, lines 25-26).

Jebens, on the other hand, teaches the digital data being digital images (digital image, col. 2, lines 64-65); and low-resolution digital image file (low-resolution copy of each of a plurality of digital images, col. 2, lines 66-67); the portion of the money paid and allocated (**claims 20 and 22**) (col. 17, lines 48- col. 18, line 5; col. 18, lines 14-18); and a notice (**claim 21**) (col. 23, lines 3-8).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Gifford, the digital images and low-resolution digital image file, the portion of money paid and allocated, and the notice, as taught by Jebens, in order to provide an automatic, integrated workflow for transferring digital assets between users (Jebens, col. 24, lines 2-4).

Regarding claims 25-26 (depend on claim 14), Gifford discloses the server allows the third party to provide data to the dynamic data (the dynamic information is imported from a third party source, col. 8, lines 11-12); and Internet (Internet, col. 3, line 19-20).

Regarding claims 29-36, Gifford discloses a system for ordering goods and/or services (e-mail notification includes not only information on what triggered the email, it also includes the online interface that links to a web brokerage application. That application then allows the client (customer) to buy or sell stocks/option (goods and/or services), col. 4, lines 50-54) over a communication network (digital communication network, col. 3, lines 14-15; local or wide-area network, col. 1, lines 18-19): a retailer (brokerage company) for receiving a product from a customer for the providing of goods and/or service for the customer (e-mail notification includes not only information on what triggered the email, it also includes the online interface that links to a web brokerage application. That application then allows the client (customer) to buy or sell stocks/option (goods and/or services), col. 4, lines 50-54); a server (Unified communications server (UC server), col. 4, lines 31-33) of a first party for sending e-mail to a receiving site of a customer (UC server sends an e-mail to a subscriber, col. 6., lines 25-26) over said communication network, the e-mail having a static section for containing static text (subscriber's message, col. 7, lines 11-13; Figure 2) and/or graphics and a dynamic area/section for containing dynamic data (Enriched E-mail has sections which contain dynamic information which are always current even if the actual e-mail message is old, col. 7, lines 46-48; Ref. no. 203, Figure 2), the dynamic data is automatically forwarded by said server to said receiving site only upon opening the e-

mail at the receiving site (since the dynamic information is kept on the UC server until the e-mail HTML interface requests it in response to a subscriber opening the e-mail, col. 7, lines 51-54; After opening the mail,.....the interaction controls also can load information dynamically and automatically into the document once the e-mail is opened, e.g. without requiring explicit user action after opening the e-mail, col. 7, lines 11-19).

However, Gifford does not explicitly disclose an order section for ordering goods and/or services; a fulfillment provider; digital data files containing digital images; the server is remote from the retailer (**claim 31**); the fulfillment provider is remote from the retailer and the server (**claims 32-33**); a portion of payment (**claims 34 and 36**); and means are provided for keeping track of which said plurality of retailers forwards which of the orders to the fulfillment provider (**claim 35**).

Gifford disclose the notification email includes not only information on what triggered the email, it also includes the online interface that links to a web brokerage application (order). That application then allows the client (customer) to buy or sell the stock/option (goods and/or services). By using the interface, the client can also request other information, which can be displayed in a Java applet or as a dynamically generated HTML page. (Col. 4, lines 50-59) Furthermore, Gifford discloses a messaging system which receives messages and provides access to those message in digital form across the digital communication network (col. 3, lines 16-19). Moreover, Gifford discloses non-liter message means a message that is not text-only or a message that needs to be rendered such as an image (col. 6, lines 16-19).

Kolls, on the other hand, teaches an order section for ordering goods and/or services, a fulfillment provider, the server is remote from the retailer (**claim 31**) and the fulfillment provider is remote from the retailer and the server (**claims 32-33**) (col. 44, lines 14-29).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Gifford, to include the order section and fulfillment provider, as taught by Kolls, in order to process the order and fulfill the order (Kolls, col. 44, lines 25-26).

Jebens, on the other hand, teaches the digital data being digital images (digital image, col. 2, lines 64-65); and a portion of payment (**claims 34 and 36**) (col. 17, lines 48- col. 18, line 5; col. 18, lines 14-18); and means are provided for keeping track of which said plurality of retailers forwards which of the orders to the fulfillment provider (**claim 35**) (col. 2, lines 35-38).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Gifford, the digital images, a portion of payment, and means for tracking, as taught by Jebens, in order to provide an automatic, integrated workflow for transferring digital assets between users (Jebens, col. 24, lines 2-4).

Claims 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gifford, Kolls and Jebens et al as applied to claim 14 above, and further in view of U.S. Patent No. 6,657,702 to Chui et al. Gifford, Kolls and Jebens substantially discloses the claimed invention, specifically, the email includes the ability

for the customer to send an e-mail to a third party for allowing access to the images (Gifford, forwarding the received message to one or more parties, col. 6, lines 6-7). However, the combination does not explicitly disclose placement of an order and the customer permits the third party to provide additional data to the images.

Chui, on the other hand, teaches the placement of an order (Figure 9; col. 21, lines 31-51) and the customer permits the third party to provide additional data to the images (col. 6, lines 34-42).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the combination , to include the placement of an order and the customer permits the third party to provide additional data to the images, as taught by Chui, in order for the user (customer) to distribute copies of prints (digital image) to recipients (third party) more quickly and with less expense and effort (Chui, col. 8, lines 54-61), thus providing increase efficiency and/or speed of the print generation and distribution task dramatically (Chui, col. 9, lines 5-6).

Response to Arguments

Applicant's arguments with respect to claims 14, 18-26, and 29-36 have been considered but are moot in view of the new ground(s) of rejection.

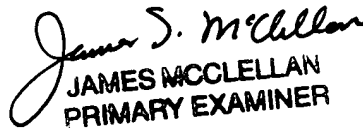
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marissa Thein whose telephone number is 571-272-6764. The examiner can normally be reached on M-F 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alex Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mtot
August 22, 2005


JAMES MCCLELLAN
PRIMARY EXAMINER